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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,186	09/25/2006	Jose Barbosa Mendes Jr	40296-10010	7100
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RYNDAK & SURI LLP				
200 W. MADISON STREET				
SUITE 2100				
CHICAGO, IL 60606				
EXAMINER				
BLATT, ERIC D				
ART UNIT		PAPER NUMBER		
3734				
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05/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,186

Applicant(s)

MENDES JR

Examiner

Eric Blatt

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 November 2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman (US 5,921,996) in view of Wilson Jr. (US 6,863,675).

Sherman discloses a surgical clip (Figures 2c-2e) comprising: a pair of curved legs 21, 22 wherein each leg has a generally planar inner surface and an outer surface and a shape that is generally a mirror image of the shape of the other leg; a flexible articulation 80 joining the pair of legs at one end, the legs being movable about the

flexible articulation from an open position to a closed position such that the inner surfaces of the legs are parallel and in contact with one another when the clip is in the closed position; and a locking mechanism 115 (Figure 2a, Col 4 Lines 53-63) for securing the legs together in a closed position. The locking mechanism is curved so that it may either extend entirely across a vessel to fully occlude the vessel or, alternatively, extend only partially across a vessel to partially occlude the vessel. The flexible articulation is integral with the legs since they together form an integral functional unit.

Although Sherman teaches using a locking mechanism for maintaining the legs in a closed position, Sherman does not disclose a locking mechanism as recited in the claims. Wilson teaches a related surgical clip having an alternate locking mechanism disposed on the end opposite the clip's flexible articulation wherein the locking mechanism comprises a pin 42 at the free end of one leg and an orifice 46 at the end of the other leg, the pin being adapted to snap fit under pressure into the orifice. These elements allow the clip to be lockable in the closed position by deformation of the clip from the open position by applying sufficient force to press the inner surfaces of the legs together. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Sherman by providing the locking mechanism of Wilson since this was a known alternative locking mechanism and its provision would not have produced unexpected results.

Regarding claims 7-9, 13-15, 20-22 and 24, Sherman does not disclose that legs comprise a plurality of teeth on their inner surfaces. Wilson teaches that it was known

to provide a plurality of teeth on an inner surface of a clip in order to enhance the engagement that the clip is able to achieve. (Figure 1) It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the apparatus of Sherman by providing a plurality of teeth on the inner surfaces of the legs in order to enhance the engagement that the clip is able to achieve as taught by Wilson. It would have been obvious to orient the teeth either transversely or longitudinally since the orientation of the teeth is an obvious matter of design choice and it appears that the device would function equally well with either configuration. In the configuration in which the teeth are oriented longitudinally, at least one tooth on the first leg will define a longitudinal ridge and at least once space between teeth on the second leg will define a longitudinal recess wherein the ridge is adapted to fit within the recess when the clip is in the closed position. Examiner notes that while Sherman discloses that the inner leg surfaces 23, 24 may be made from a soft compressible material such as foam rubber or silicone to minimize trauma to the tissue contacted, the teeth may also be made from such a soft compressible material to minimize trauma while additionally enhancing engagement.

Regarding claims 10 and 11, Sherman discloses that at least a portion of the clip is formed of polymer material. (Col 4, Lines 33-36) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Sherman by having the clip be formed of metal since metal was known by those of skill in the art at an accepted material from which to form medical clips.

Regarding claims 25-28, the clip is laterally curved so that it may be used either fully or partially occlude a blood vessel as previously discussed. It is therefore capable of achieving the partially occlusive and fully occlusive orientations recited in claims 25-28.

Response to Arguments

Applicant's arguments with respect to claims 5-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Blatt/
Examiner, Art Unit 3734

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734